

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* JOSE MARIA DIONISIO REOBASCO and
9 EZEQUIEL ROBERTO LAZAGA
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12 Appeal 2007-2793
13 Application 10/280,164
14 Technology Center 3600
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17 Decided: January 22, 2008
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20 Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and
21 ANTON W. FETTING, *Administrative Patent Judges*.
22 FETTING, *Administrative Patent Judge*.

23 DECISION ON APPEAL
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25

26 STATEMENT OF CASE

27 Jose Maria Dionisio and Ezequiel Roberto Lazaga (Appellants) seek
28 review under 35 U.S.C. § 134 of a Final Rejection of claims 16-30, the only
29 claims pending in the application on appeal.

30 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
31 (2002).

1 We AFFIRM.

2 The Appellants invented an advertising device for use in machines
3 dispensing products and/or services. The device may be a gaming device
4 which can be combined with product dispensing machines, such as machines
5 dispensing food, beverages, and the like. (Specification 1:First ¶).

6 An understanding of the invention can be derived from a reading of
7 exemplary claim 16, which is reproduced below [bracketed matter and some
8 paragraphing added].

9 16. A promotion device attachable to a product and/or service
10 dispensing machine, comprising:

11 [1] an actuator;

12 [2] a dispensing slot;

13 [3] a program comprising routines and parameters that controls
14 said promotion device;

15 [4] at least one algorithm triggerable by said actuator for
16 executing a random routine in response [to] the insertion of
17 money into the machine and a product or service being selected;

18 [5] said random routine of said algorithm determining if a prize
19 has been won;

20 [6] said prize being dispensed from at least one of said machine
21 and said dispensing slot, depending upon the nature of said
22 prize.

23

24 This appeal arises from the Examiner's Final Rejection, mailed January
25 25, 2006. The Appellants filed an Appeal Brief in support of the appeal on
26 August 28, 2006. An Examiner's Answer to the Appeal Brief was mailed on
27 October 20, 2006. A Reply Brief was filed on December 22, 2006.

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PRIOR ART

The Examiner relies upon the following prior art:

Williams	US 4,869,500	Sep. 26, 1989
Eggleston	US 6,061,660	May 9, 2000
Kaehler	US 2002/0107610 A1	Aug. 8, 2002

REJECTION

Claims 16-30 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Williams, Eggleston, and Kaehler.

ISSUES

The issue pertinent to this appeal is whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 16-30 under 35 U.S.C. § 103(a) as unpatentable over Williams, Eggleston, and Kaehler.

The pertinent issue turns on whether it was obvious in view of the references to have attached a game of chance to a vending machine where the game would dispense prizes based upon money insertion and product selection.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are supported by a preponderance of the evidence.

Williams

01. Williams is directed toward a vending machine incorporating or in combination with a game device. Williams' device is operable,

1 at the user's choice, in a pure vend mode or in a play and vend
2 mode. A user who wins can receive a prize in cash or kind. A won
3 prize can be combined with a user's stake (a number of coins or
4 tokens fed into the machine) to provide effectively a free vend or a
5 reduced price vend (Williams 1:10-20).

6 02. Williams' device may have a vend part and a game part. The
7 parts can be integral, or the game part can be an additional item
8 secured to an existing vending machine. A user can use the
9 vending machine in a pure vend mode or, if the user wishes to
10 take the game option, place his coin or token into a second
11 mechanism (Williams 1:53-65; 2:63-65).

12 03. Williams describes how the rules and operating parameters of
13 the game can control the screen and software controlling operation
14 of the game. The game can be changed at will by changing the
15 software (Williams 3:8-11).

16 04. Williams describes prizes in the form of credit (Williams 2:45-
17 47), cash or tokens, or an article (Williams 3:42-44).

18 05. Williams also describes simulating the action of the object of
19 the game, in Williams' case simulating a missile firing (Williams
20 2:16-39).

21 06. Williams illustrates a plunger that activates a game round
22 (Williams Fig. 1:17).

23

24

1 *Eggleston*

2 07. Eggleston is directed toward an incentive program and award
3 system to permit sponsors to build, buy, store, modify, offer, track
4 and administer incentive programs and to permit sponsors and
5 retailers to offer improved award fulfillment for participants in
6 incentive programs (Eggleston 5:47-54).

7 08. Eggleston describes its programs as including games of chance
8 (Eggleston 19:3-5).

9 09. Eggleston describes how, by flashing a series of HTML pages
10 to the consumer, the appearance of motion can be created. For
11 example, a series of pages depicting a pinball machine can be
12 displayed, creating a sense of dynamic motion as pages are
13 sequentially displayed. This approach is the same as in any
14 conventional Internet computer game that includes moving
15 graphical images (Eggleston 33:20-30).

16 *Kaehler*

17 10. Kaehler is directed toward a remote transaction station to
18 dispense special vending products at random, and to recognize
19 such products to additionally vend to the customer the selected
20 product (Kaehler ¶ 0001).

21 11. Kaehler describes the decision to dispense a prize as based on a
22 pseudo random number generator, the product ordered, and
23 marketing factors, such as the mode of payment (Kaehler ¶'s
24 0009-0010).

1 Although a patent applicant is entitled to be his or her own lexicographer
2 of patent claim terms, in *ex parte* prosecution it must be within limits. *In re*
3 *Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing
4 such definitions in the Specification with sufficient clarity to provide a
5 person of ordinary skill in the art with clear and precise notice of the
6 meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480
7 (Fed. Cir. 1994) (although an inventor is free to define the specific terms
8 used to describe the invention, this must be done with reasonable clarity,
9 deliberateness, and precision; where an inventor chooses to give terms
10 uncommon meanings, the inventor must set out any uncommon definition in
11 some manner within the patent disclosure so as to give one of ordinary skill
12 in the art notice of the change).

13 *Obviousness*

14 A claimed invention is unpatentable if the differences between it and
15 the prior art are “such that the subject matter as a whole would have been
16 obvious at the time the invention was made to a person having ordinary skill
17 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct.
18 1727 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

19 In *Graham*, the Court held that that the obviousness analysis is
20 bottomed on several basic factual inquiries: “[1] the scope and content of
21 the prior art are to be determined; [(2)] differences between the prior art and
22 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
23 in the pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex*
24 *Inc.*, 127 S.Ct. at 1734. “The combination of familiar elements according to
25 known methods is likely to be obvious when it does no more than yield
26 predictable results.” *KSR*, at 1739.

1 “When a work is available in one field of endeavor, design incentives
2 and other market forces can prompt variations of it, either in the same field
3 or in a different one. If a person of ordinary skill in the art can implement a
4 predictable variation, § 103 likely bars its patentability.” *Id.* at 1740.

5 “For the same reason, if a technique has been used to improve one
6 device, and a person of ordinary skill in the art would recognize that it would
7 improve similar devices in the same way, using the technique is obvious
8 unless its actual application is beyond his or her skill.” *Id.*

9 “Under the correct analysis, any need or problem known in the field
10 of endeavor at the time of invention and addressed by the patent can provide
11 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

12 ANALYSIS

13 *Claims 16-30 rejected under 35 U.S.C. § 103(a) as unpatentable over*
14 *Williams, Eggleston, and Kaehler.*

15 *Claim 16*

16 The Appellants argue claims 16-20, 22, 23, and 25 as a group.

17 Accordingly, we select claim 16 as representative of the group.
18 37 C.F.R. § 41.37(c)(1)(vii) (2007).

19 The Examiner found that Williams describes the structural elements [1],
20 [2], and [3], and the algorithm triggered by an actuator in response to money
21 and product selection of element [4], the prize determination of element [5],
22 and the dispensing from a slot depending on the nature of the prize of
23 element [6] of claim 16. The Examiner found that Eggleston describes
24 games having random components for winning prizes and Kaehler describes

1 vending machines having random components for dispensing products as
2 promotional prizes (Answer 3-6).

3 The Examiner implicitly found that one of ordinary skill would have
4 understood that Eggleston's games would be of interest to users of games
5 such as that in Williams and that Williams' game would be useful to add
6 onto Kaehler's vending machine to provide additional game components to
7 Kaehler's machine (Answer 4-5).

8 The Examiner concluded it would have been obvious to one of ordinary
9 skill to have combined Williams' game device with Kaehler's vending
10 machine using a game of chance as well as skill in the gaming device
11 because of these understandings by one of ordinary skill (Answer 4-5).

12 The Appellants contend that none of Williams, Eggleston or Kaehler
13 describes a separate dispensing slot, i.e. element [2] (Br. 12:Last full ¶). We
14 find, as the Examiner points out, that Williams describes its game device as
15 alternately being additional and securable to a vending machine (Answer 3;
16 FF 02). Since Williams can dispense coins, tokens or product, both the
17 suggestion of the game device being a separate machine, and Williams' two
18 coin slots (Williams Fig. 1), the upper slot being a separate slot which could
19 be used to dispense coin prizes, suggest that a slot for prizes would have
20 been either present in Williams' second coin slot or a predictable variation
21 as a separate slot in Williams' separate machine for product awards.

22 The Appellants next contend that none of Williams, Eggleston or
23 Kaehler describes element [4], an algorithm, triggerable by an actuator,
24 executing a random routine in response the insertion of money into the
25 machine and a product or service being selected.

1 We find that, as pointed out by the Examiner, Kaehler is triggered by
2 sensing that a transaction has begun, thus this sensing portion acting as an
3 actuator (Answer 6, FF 10), and that Williams has a more explicit actuator, a
4 plunger (FF 06) that activates a game round.

5 The Appellants argue that Kaehler is not triggered by selection of a
6 product in addition to money deposit (Br. 13:Last ¶). As the Examiner
7 points out, Kaehler only dispenses the special product that it awards after
8 both the steps of payment and product selection have occurred (Answer 6;
9 FF 15). Since this dispensing is controlled by the algorithm that decides
10 when to dispense a special product, and this algorithm contains random
11 routines (FF 10), the algorithm executes a routine containing a random
12 component in response to the insertion of money into the machine and a
13 product or service being selected. Moreover, Kaehler's routine to dispense a
14 prize is based on a pseudo random number generator, the product ordered,
15 and marketing factors, such as the mode of payment (FF 10). Also, Kaehler
16 describes an alternate embodiment in a kiosk that may be responsive to both
17 money and product selection (FF 12).

18 The Appellants argue that Williams is a game of skill, not of chance and
19 so its algorithm is not a random routine (Br. 10: First ¶). We find that this is
20 merely characterizing the nature of the game in which prizes are awarded.
21 Certainly games combining chance with the skill of Williams are notoriously
22 known to be of entertainment value, which is the reason Williams uses a
23 game, and both Eggleston and Kaehler suggest using algorithms to award
24 prizes with some random component. Eggleston describes games of chance
25 as instances of improved award fulfillment programs (FF 08).

1 The Appellants also argue that Eggleston requires registration (Br. 11:
2 Second full ¶). We find that this argument is not commensurate with the
3 scope of the claim. Since the claim makes no mention of registration, or of
4 not requiring registration, registration is not pertinent to patentability.

5

6 *Claim 21*

7 The Appellants separately argue claim 21, which further requires that the
8 machine dispenses services and said prize is a partial or total credit for the
9 cost of such services. The Appellants contend that neither Kaehler nor
10 Williams dispenses services and that Eggleston does not disclose
11 reimbursement (Br. 14).

12 We disagree. We find that, as the Examiner found, Williams describes
13 credits as prizes and that Williams dispenses games, which are services
14 (Answer 10-11; FF 02 - 04). We further find that Kaehler describes
15 vending services in addition to products (FF 13).

16 *Claim 24*

17 The Appellants separately argue claim 24, which further requires a
18 display providing simulated movement of a chance device during the
19 operation of said algorithm. The Appellants contend that none of Kaehler,
20 Williams, or Eggleston describes this (Br. 15).

21 We disagree. We find that, as the Examiner found, Eggleston describes
22 a display simulating a pinball machine (Answer 11; FF 09). Since the
23 motion of a ball in pinball contains a random component, this would present
24 simulated movement of a chance device. Also, we find that Williams

1 describes simulating the action of the object of the game, in Williams' case
2 simulating a missile firing (FF 05). Although Williams' game is not
3 described as being one of chance, Eggleston describes its programs as
4 including games of chance (FF 08) and would have suggested offering
5 games of chance in Williams as award fulfillment. Further, Williams does
6 suggest presenting a simulated activity representing the game, such as a
7 game of chance in accordance with Eggleston's teachings, being played.

8 *Claims 28-30*

9 The Appellants argue claims 28 and 30 based on the same reasoning as
10 claim 21, and claim 29 based on the same reasoning as claim 24 (Br. 16-17).
11 Thus, we find these arguments to be unpersuasive for the reasons we stated,
12 *supra*.

13 *Claims 26-27*

14 The Appellants argue claims 26-27 as a group.

15 Accordingly, we select claim 26 as representative of the group.

16 Claim 26 is a method performed by the devices of claims 21 and 28, and
17 requires that if the algorithm determines a prize is to be awarded,
18 determining the prize to be awarded is based upon preconfigured parameters
19 in the program. The Appellants argue that none of Kaehler, Williams, nor
20 Eggleston describe determining the prize to be awarded based upon
21 preconfigured parameters (Br. 17-18).

22 We disagree. We find, as the Examiner found, that Kaehler describes
23 how operation of its pseudo-random number generator may be influenced by
24 various factors, and may be tailored to marketing goals (Answer 13, FF 11 &

1 14) and Williams describes the use of parameters to control the software that
2 controls its game (FF 03). Since in both Kaehler and Williams, the software
3 controls the prize that is dispensed, they both describe determining the prize
4 to be awarded based upon preconfigured parameters in the program. In
5 particular, Williams describes alternative awards that may be provided (FF
6 04).

7 **CONCLUSIONS OF LAW**

8 The Appellants have not sustained their burden of showing that the
9 Examiner erred in rejecting claims 16-30 under 35 U.S.C. § 103(a) as
10 unpatentable over the prior art.

11 **DECISION**

12 To summarize, our decision is as follows:

- 13 • The rejection of claims 16-30 under 35 U.S.C. § 103(a) as
14 unpatentable over Williams, Eggleston, and Kaehler is sustained.

15 No time period for taking any subsequent action in connection with this
16 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

17
18 **AFFIRMED**

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20 vsh

21 GREER, BURNS & CRAIN
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